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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,770	07/21/2003	Philip Lim-Kong Wong	029014.44732C1	4226
23911 7590 12/19/2006 CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			EXAMINER OROPEZA, FRANCES P	
			ART UNIT	PAPER NUMBER
			3766	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/19/2006	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/622,770

Applicant(s)

WONG ET AL.

Examiner

Frances P. Oropeza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/26/06 (Response) and 6/22/06 (Reply).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

#### ***Response***

1. In the responses filed 6/22/06 and 9/26/06, the Applicant noted a correction of the Bib Data Sheet would be filed, however no paperwork appears to have been submitted. The Applicant also appears to have failed to respond to paragraph 5 below. The Applicant is encouraged to respond to paragraphs 4 and 5 in the next response to avoid a non-responsive reply.

2. The Applicant's arguments filed 9/26/06 have been fully considered and they are convincing. The Notice of Non-Compliant Amendment is withdrawn.

3. The Applicant's arguments filed 6/22/06 have been fully considered, but they are not convincing. The arguments are discussed below under the appropriate rejection.

#### ***Confusion with Serial Number***

4. The Request for Filing a Patent Application submitted 7/21/03 indicates the pending prior application is 09/834832. This number is incorrect. The pending prior application is indicated as 09/843892 on the Bib Date Sheet. This number is also incorrect. The correct number is believed to be 09/834892. Appropriate correction is required.

***Priority***

5. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 120, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an

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unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

### ***Claim Rejections - 35 USC § 103***

6. Claims 1, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakumoto et al. (US 6449583) in view of Sham et al. (US 5661398).

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Sakumoto et al. disclose a portable measurement apparatus for directly measuring time, distance and pulse rate (col. 2 @ 12-28 and col. 8 @ 45-50). Lap time/split time are measured using a lap button (col. 4 @ 29-35; col. 5 @ 44-50; col. 8 @ 2-3) requiring user intervention (col. 5 @ 25-32). A display section (104) on the device is used to view the data (col. 4 @ 20-28).

Sakumoto discloses the claimed invention except for the lap sensing device outputting a first signal.

Sham et al. disclose a lap sensing device and teach that it is known to use two magnetic field sensors to automatically count laps by monitoring bearings readings and providing an output signal (col. 2 @ 12-19). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the a portable measurement apparatus as taught by Sakumoto et al., with the lap sensing device as taught by Sham et al. to provide an apparatus that automatically senses and monitors laps and lap performance so the athlete can focus on the fitness activity and not be concerned with measuring the laps.

As to distance traveled, Sham et al. (US 5661398) discloses the microprocessor (19) can provide the total distance traveled (col. 6 @ 3-6).

As to time traveled, Sham et al. (US 5661398) discloses the microprocessor (19) can provide the total elapsed time (col. @ 3-6).

As to distance and time of the laps, Sham et al. (US 5661398) discloses the microprocessor (19) can provide the split time indicating the distance / time relationship (col. 6 @ 3-6).

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As to the lap signal being continuous, Sham et al. (US 5661398) disclose the lap counting device can continuously output a signal indicating the completion of a lap or portion thereof (col. 2 @ 14-19; col. 5 @ 66 – col. 6 @ 2).

The Applicant's arguments filed 6/22/06 have been fully considered but they are not convincing.

The Applicant asserts Sakumoto et al. do not teach measurement of distance based on the output of a sensor. The Examiner disagrees. Sakumoto et al. teach measurement of distance based on the output of a sensor (col. 2 @ 17 – a measurement means for measuring distance) (col. 8 @ 45-50, 59-61 – GSP sensor to measure distance) that is sensitive to movement (col. 9 @ 2-3, 9-10 – distance covered is monitored hence the sensor is read to be sensitive to movement – change of place or location).

The Applicant asserts Sakumoto et al. do not teach a synchronized signal in response to a lap sensor. The Examiner disagrees. Sakumoto et al. teach a lap sensor as a period of time/ split time/ lap time is measured by a GSP sensor (col. 2 @ 15 – a measurement means for measuring a period of time/ split time/ lap time) (col. 8 @ 45-50, 59-61; col. 9 @ 2-3 – GSP sensor to measure distance and time) to measures the number of laps completed (col. 9 @ 10). Sakumoto et al. teach a synchronized signal in response to a lap sensor and a distance traveled in as much as common sensors are used in the control section (105) to gain measurement signal, the signal used to determine different information, hence the signals are synchronized (Webster's Ninth New Collegiate Dictionary – synchronized is defined as to happen at the same time).

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In response to the Applicant's arguments that the references fail to show certain features of the Applicant's invention, it is noted that the feature upon which the Applicant relies (i.e. total distance covered) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakumoto et al. (US 6449583) in view of Sham et al. (US 5661398) and further in view of Sham et al. (US 5891042). As discussed in paragraph 4 of this action, modified Sakumoto et al. disclose a measurement apparatus using a Global Positioning System, as an example, (col. 8 @ 46-50), to measure speed and distance, but also allow for alternate speed and distance measuring mechanisms (col. 9 @ 37-50). Sakumoto et al. disclose the claimed invention except for the motion sensor being a step sensor with a piezoelectric sensor.

Sham et al. (US 5891042) disclose a fitness monitoring device and teaches the use of a step sensor with a piezoelectric sensor to measure distance. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified portable measurement apparatus as taught by Sakumoto et al., with the step sensor with a piezoelectric sensor as taught by Sham et al. (US 5891042) to provide a convenient means for monitoring movement not using a Global Positioning System so a reliable fitness monitoring system is provided to the athlete to monitor his/her athletic performance (col. 1 @ 32-35).



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8. Claims 3, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakumoto et al. (US.6449583) in view of Sham et al. (US 5661398) and further in view of Kuehn et al. (US 4037328). As discussed in paragraph 4 of this action, modified Sakamoto et al. disclose the claimed invention except for the motion sensor being a swim stroke sensor with a Hall-effect sensor to monitor movement and a voltage controlled oscillator to determine the direction of movement.

Kuehn et al. (US 4037328) disclose a spatial orientation device and teaches the use of a swim stroke sensor with a Hall-effect sensor to determine movement and a voltage controlled oscillator to determine the direction of movement (col. 3 @ 31-34 and col. 4 @ 47-52). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified portable measurement apparatus as taught by Sakumoto et al., with a swim stroke sensor with a Hall-effect sensor and a voltage controlled oscillator as taught by Kuehn et al. to provide a means to monitor movement and direction in the water when the fitness monitoring system is used to monitor the athlete's performance and the fitness activity is swimming.

***Statutory Basis***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

*Conclusion*


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fran Oropeza whose telephone number is (571) 272-4953. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and for After Final communications.

Frances P. Oropeza  
Patent Examiner  
Art Unit 3766

*FPO*  
*12/10/06*

  
Robert E. Pezzuto  
Supervisory Patent Examiner  
Art Unit 3766